

R E M A R K S

- Claims **1-44 and 46-167** are pending in the present application
- Claim 45 was previously cancelled
- Claims **75-86, 88-93, 96-143 and 154-161** are pending and have been withdrawn from consideration
- No claims stand rejected
- Claims **1, 48, 58, 75-79, 81-88, 90-96, 107-112, 125, 129-131, 136-138, and 144-167** are the only independent claims

A. Clarification as to pending claims

The Examiner's Office Action Summary page indicates that only Claims 1-44, 46-53, 58-74, 87, 94, 95, 144-149, 150-153, and 162-167 are pending.

That is incorrect.

As indicated in the Amendment & Response filed March 15, 2005, all of **Claims 1-44 and 46-167 are pending**. Claims 75-86, 88-93, 96-143 and 154-161 were previously withdrawn, not cancelled.

We request that the Examiner clarify for the record that all of Claims 1-44 and 46-167 are still pending, and that all of Claims 75-86, 88-93, 96-143 and 154-161 are withdrawn from consideration.

B. Claims 2-7, 34-38, 46, 47, 53-57, 63-69 have been provisionally elected

The Examiner has required an Election/Restriction of species, alleging that two patentably distinct species are present in the pending claims.

Although we do not understand the Examiner's designated species, we provisionally elect for examination Claims 2-7, 34-38, 53, and 63-69 ("Species I") with traverse.

We also provisionally elect Claims 46, 47, and 54-57. We note that Claims 46, 47, and 54-57 were not addressed. As we find the Examiner's designated species to be illogical and inconsistent, for the reasons stated below, we do not presume to speculate as to which alleged species Claims 46, 47, and 54-57 are directed (if any).

As explained below, the Examiner's requirement for restriction is (i) based on an illogical and inconsistent designation of species that is contrary to the plain language of the claims, (ii) being asserted with respect to claims that have already been examined and rejected three times, (iii) includes no hint of evidence of a new and serious burden on examination, and (iv) includes no hint that the claims are restricted to species by mutually exclusive characteristics.

We note that Claims 94 and 95 are improperly designated as both Species II and generic. If the Examiner does not withdraw the restriction, we request the Examiner correct this error.

C. The Election/Restriction of Species is Improper

C.1. Election/Restriction

In the instant Office Action, the Examiner has required an Election/Restriction, alleging that Claims 2-7,34-38,53, and 63-69 (Examiner's "Species I") are patentably distinct from Claim 8-33, 39-44, 49-52, 58-62, 70-74, 94, 150, 151, 152, 153, 166 and 167 (Examiner's "Species II").

The indicated claims of Species I and Species II have been examined and rejected a total of three times. See Office Actions mailed September 5, 2002, August 25, 2003, and August 27, 2004.

All of the pending claims were also subject to a prior requirement of election/restriction. See Office Action mailed May 15, 2003.

The Examiner has additionally performed a recent set of searches with respect to the pending claims. See IFW, August 12, 2005 (indicating Searches Ref #L1-L5 between 2005/08/12 12:31 and 12:33).

We assert that at least in light of the three prior examinations and the most recent search, the Patent and Trademark Office has had ample opportunity to examine the pending claims, and that the Examiner's continued examination of the instant claims would place no additional burden on the Examiner than has been carried already. See MPEP §803.

We traverse the Examiner's assertion that the restriction is "complex." The Examiner has only designated two species.

Consequently, Applicants respectfully request the reconsideration and withdrawal of the current Election/Restriction of species.

C.2. The designation of species is illogical and inconsistent

The Examiner does not appear to have construed the claims properly in making the designation of alleged “patentably distinct” species. The Examiner’s designation of species is illogical and defies the plain language of the claims.

The Examiner asserts that Claim 2 (Species I) recites “that the qualifying action is performed by a second recipient of said coupon.” We do not agree. Claim 2 recites that the qualifying action may be associated with one or more of the following types of recipients: an initial recipient, a primary recipient, a secondary recipient, and a tertiary recipient. Thus the literal language is contrary to the Examiner’s interpretation that Claim 2 requires performance by a “second recipient” in particular.

Similarly, the Examiner also appears to have misinterpreted Claims 3, 4, and 7 (Species I), which do not literally require performing of any qualifying action by a “second recipient,” only associating a qualifying action with the “second recipient.”

The Examiner asserts that Claim 21 (Species II) recites “that the qualifying action is performed by the initial recipient of the coupon.” We do not agree. Claim 21 explicitly recites that the qualifying action may include any one or more of a variety of actions, including an action by a first recipient, an initial recipient, a primary recipient, a secondary recipient, a tertiary recipient, or a recipient. Thus the literal language is contrary to the Examiner’s interpretation that Claim 21 requires performance by an “initial recipient” in particular. Clearly, despite the Examiner’s implication, embodiments with actions by one type recipient are not mutually exclusive from embodiments with actions by another type of recipient.

Similarly, the Examiner appears to have misinterpreted Claim 8 (Species II), which recites a qualifying action associated with a second recipient (as recited in Claim 3, from which Claim 8 indirectly depends) and a second qualifying action including one or more actions by a first recipient. It is not clear why the Examiner has designated Claim 8 as Species II (“qualifying action is performed by the initial recipient”) where respective actions are associated with a first and with a second recipient. Clearly, despite the Examiner’s implication, embodiments with actions by a first recipient are not mutually exclusive from embodiments with actions by a second recipient.

With respect to Claims 9-20, 22-33, 39-44, 94, 95 (Species II), we do not understand why the Examiner believes those claims to be directed to Species II (“qualifying action is performed by the initial recipient”). Some of those claims do

not specify any particular type of recipient (*e.g.*, Claim 14), and none of the claims requires performance by an “initial recipient.” The Examiner appears to have labeled those claims as Species II merely because they do not include the term “second recipient.” We believe that this designation is arbitrary and reflects a failure to properly consider the claimed subject matter. For instance, if Claim 1 is generic, as indicated by the Examiner, why are Claims 9-20, 22-23, 39-44, 94, 95 directed to Species II when none of the claims includes the term “initial recipient”?

Claims 94 and 95 are also designated as generic; we request correction by the Examiner.

With respect to Claims 34-38 and 63 (Species I), we do not understand why the Examiner believes those claims to be directed to Species I. Claim 34, for example, explicitly recites that a coupon’s benefit increases a first amount if an initial recipient of said coupon forwards said coupon to a primary recipient. Claim 63 explicitly recites that the qualifying action includes forwarding of said coupon by said first recipient. Even though these claims clearly recite an action performed by an initial recipient or a first recipient, the Examiner designates these claims as Species I (“qualifying action is performed by a second recipient of said coupon”).

With respect to Claim 49 (Species II), we do not understand why the Examiner believes that claim to be directed to Species II (“qualifying action is performed by the initial recipient of the coupon”). Claim 49, for example, explicitly recites that a coupon is provided to at least one initial recipient. Claim 49 does not require performance of any action by any particular type of recipient, much less an “initial recipient,” as asserted by the Examiner. Nonetheless, the Examiner designates this claim as Species II.

The Examiner appears to have misinterpreted Claims 53 (Species I), which recites a qualifying action including an action by an initial recipient (as recited in Claim 50, from which Claim 53 indirectly depends) and a second qualifying action including an action by a primary recipient. It is not clear why the Examiner has designated Claim 53 as Species I (“qualifying action is performed by a second recipient of said coupon”) where respective actions include actions by an initial recipient and by a primary recipient. Clearly, despite the Examiner’s implication, embodiments with actions by an initial recipient are not mutually exclusive from embodiments with actions by a primary recipient.

The Examiner appears to have misinterpreted Claims 64, 65, and 67-69 (Species I), each of which recites (i) completion of a first qualifying action by a first recipient (as recited in Claim 58, from which those claims directly or indirectly depend) and (ii) an action by a second recipient (or third recipient). It is

not clear why the Examiner has designated Claims 64, 65, and 67-69 as Species I (“qualifying action is performed by a second recipient of said coupon”) where actions are performed or completed by both a first recipient and a second recipient (or third recipient). Clearly, despite the Examiner’s implication, embodiments with actions performed by a first recipient are not mutually exclusive from embodiments with actions by a second recipient.

C.3. Claims not directed to mutually exclusive characteristics

MPEP 806.04(f) is entitled "Claims Restricted to Species, by Mutually Exclusive Characteristics" and states that:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

As demonstrated by the discussion above with respect to the Examiner’s illogical and inconsistent designation of species, performance of an action by one type of recipient does not mutually exclude performance of an action by another type of recipient. The Examiner has not even attempted to establish that the claims of the designated species are directed to mutually exclusive characteristics. Thus, the Examiner has failed to establish a *prima facie* case that an election of species is required.

C.4. The Examiner has Failed to Establish a Serious Burden

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper “[i]f the search and examination of [the] entire application can be made without serious burden.” MPEP §803.

Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists as the instant claims have already been examiner together three times. In particular, the Examiner has failed to show that (1) there is a separate classification of the alleged species which would necessitate a separate field of search; (2) the alleged species cannot be searched using the same field of search without unduly burdening the Examiner; and (3) any alleged Species are related to any class of invention which has achieved a separate status in the art. See, MPEP §808.02.

Also, the Examiner has only designated two allegedly distinct species. The Examiner has not provided any indication as to why only the two indicated species "exceed a reasonable number" of species. A reasonable number of species may be claimed in one national application; the Examiner does not attempt to explain why the number of designated species (two) is unreasonable. See 37 C.F.R. § 1.141.

In general, Applicants believe that the claims all can readily be searched and examined together without serious burden on the Examiner. Indeed, as mentioned above, a plurality of such searches have already been conducted. Thus, without further showing of a serious burden upon the Examiner, Applicants respectfully assert that the Examiner has failed to meet all of the requirements of the MPEP to make a proper Election/Restriction of the instant claims.



D. Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

August 30, 2005

Date

A handwritten signature in black ink, appearing to read "Michael Downs".

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